

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Kwasi ASARE, et al.	:	Confirmation Number: 5007
	:	
Application No.: 10/725,612	:	Group Art Unit: 2191
	:	
Filed: December 2, 2003	:	Examiner: Q. Chen
	:	
For: OPTIMAL COMPONENT INSTALLATION	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated June 6, 2007.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of March 29, 2007, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal Brief of March 29, 2007, and the arguments set forth below.

THE REJECTION OF CLAIMS 7 AND 8 UNDER 35 U.S.C. § 101

On pages 4 and 5 of the Appeal Brief, Appellants argued: (i) claim 7 is directed to a machine; (ii) claim 7 is not directed to "software, *per se*," as alleged by the Examiner; and (iii) the claim limitations recite functional components (i.e., a device). The Examiner responded to these arguments on pages 12 and 13 of the Examiner's Answer. Initially, the Examiner asserted the following:

Appellant argues that the claimed invention is not directed to software *per se*, but instead, to a system (see Appeal Brief - page 5). The Examiner maintains that the 35 U.S.C. § 101 rejections of Claims 7 and 8 are consistent with the Office's current policies regarding non-statutory subject matter. Appellant has submitted that the "claimed system must be coupled to physical components (i.e., hardware) to be functional (see Appeal Brief—page 5)." However, the recited components of the systems appear to lack the necessary physical components (hardware) to constitute a machine or manufacture under § 101. (underline added)

The Examiner appears to have confused the requirements of enablement under the 1st paragraph of 35 U.S.C. § 112, the requirement that the claimed invention be directed to statutory subject matter under 35 U.S.C. § 112.

Claims are only required to "particularly [point] out and distinctly [claim] the subject matter which the applicant regards as his invention."¹ Thus, the claims are not required to "enable" the practice of the claimed invention. Instead, "[t]he specification shall contain a written description of the invention ... to enable any person skilled in the art ... to make and use the same."²

For example, a claim to a computer may not recite a power supply, yet without a power supply, the computer would be non-functional, and it is well established that "non-functional" devices are not statutory subject matter. Despite reviewing multitudes of issued patents directed

¹ Second paragraph of 35 U.S.C. § 112.

² First paragraph of 35 U.S.C. § 112.

to computers, Appellants are unaware of any apparent requirement that claims directed to computers recite a power supply (i.e., corresponding to the Examiner's "necessary physical components"). Appellants, therefore, respectfully submit that the claims are not required to recite all necessary physical components to enable the practice of the invention.

The Examiner further asserted the following:

Although the claims recite a script processor and a requirements verification processor, the Examiner has reasons to believe that the recited processors of the systems can be reasonably interpreted as computer program modules - software per se, since the originally-filed specification provides no support for the processors as being hardware processors (i.e., central processing units). Thus, absent an explicit and deliberate definition of what constitutes a processor, the claimed processors are interpreted as software per se under the broadest reasonable treatment. Furthermore, the originally-filed specification discloses that the present invention can be realized in software (see page 14, paragraph [0030]). Therefore, the claims are directed to functional descriptive material per se, and hence non-statutory.

Again, the Examiner does appear to understand the concept of "software, *per se*." Software, *per se* (i.e., without anything else), is an abstract idea, and as an abstract idea, the software is non-functional, and therefore, does not produce a useful, concrete, tangible result. In this regard, Appellants note that the Examiner has not alleged the claimed invention does not produce a useful, concrete, tangible result.

Although the Examiner asserted that the "claimed processors are interpreted as software per se under the broadest reasonable treatment," the Examiner has failed to set forth any evidence that supports the Examiner's assertion that one having ordinary skill in the art, given the ordinary and customary meaning of the term "processor," would consider a processor to be software, *per se*. Moreover, the Examiner's reliance on paragraph [0030] of Appellants' disclosure to define the invention is improper since the claims define the invention and not the specification.

THE REJECTION OF CLAIMS 1-2, 4, 6-8, 10-11, 13, AND 15 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON ZIMNIEWICZ IN VIEW OF DONOHUE

Independent claim 1 recites that the claimed "enforcing" step occurs "prior to installing said subject application component." Moreover, claim 1 recites that the enforcing step includes the step of "updating dated ones." Thus, the claimed step of "updating dated ones" occurs prior to installing the subject application component. The Examiner has already admitted that Zimniewicz does not teach the claimed "updating dated ones" step, and the Examiner relied upon Donohue to teach this step (see page 6 of the Examiner's Answer). As argued on page 12 of the First Amendment and repeated on page 5 of the Appeal Brief:

Applicants respectfully submit that even if one having ordinary skill in the art were motivated to modify Zimniewicz in view of Donohue, the claimed invention would not result. Independent claims 1 and 10 specifically recite the claimed enforcing step occurs "prior to installing said subject application component." Although Donohue teaches "applying updates to programs installed on the local system" (column 9, lines 48-49), Donohue is silent with regard to when the updating occurs during the installation of a subject application component. (emphasis in original)

On pages 6 and 7 of the Appeal Brief, Appellants further argued that Donohue teaches away from the claimed invention by teaching that the updating occurs after the subject application has been installed instead of the claimed "prior to installing said subject application component" (emphasis added).

On page 13 of the Examiner's Answer, the Examiner responded to Appellants' arguments as follows:

Examiner would like to point out that Donohue is relied upon solely for the rejection of the particular claim limitation "updating dated ones of said required ones of said dependencies which can be accessed in said target platform with updated versions of said required ones of said dependencies," which Donohue clearly discloses.

In this regard, Appellants note that it is not proper for the Examiner to pick and choose from certain passages of the prior art and ignore disclosure that teaches away from the claimed invention. As discussed in M.P.E.P. § 2141.02(VI), "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis added).³ By ignoring all of the teachings of the applied prior art, including those that teach away from the claimed invention, the Examiner has failed to properly consider Donohue, in its entirety.

The Examiner further asserted the following on page 14 of the Examiner's Answer:

Thus, if the required software can be accessed in the local computer system, then updates to the pre-requisite software are performed to bring them to the required levels. Appellant has not presented arguments against this interpretation, but instead argues a feature that is not expressly recited in the particular claim limitation. Specifically, there is no requirement in the plain language of the particular claim limitation with regard to when the updating occurs. (bolding and underlined separately added)

As already noted above, the language of claim 1 is crystal clear. The claimed enforcing step is performed "prior to installing said subject application component," and the "enforcing step comprises the steps of ... updating dated ones." Thus, it appears that the Examiner has improperly ignored this limitation based upon the underlined portion in the above-reproduced paragraph.

Referring to the bolded language in the above-reproduced paragraph, Appellants note that the Examiner admits that Donohue does not teach this limitation. For the "required software" to be accessible in the local computer system, the "required software" is already installed in the

³ W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

local computer system. Thus, any "updates to the pre-requisite software" is performed after the "require software" has been installed, which is completely opposite to that claimed.

The Examiner still attempted to address this issue by asserting the following in the first full paragraph on page 14 of the Examiner's Answer:

However, the Examiner would like to respond to this argument by stating that Donohue clearly disclose that the updating occurs prior to the installation of a subject application component (see Column 20: 3-17, "*For all pre-requisites which are not already in place at the required revision level, an update is forced on their associated updater agents to make them migrate to the required level.*" and 65-67, "*The updater component then implements the actual software upgrade: >>>>START Install resources ()*"). Thus, prior to installing an upgrade of the software application, all pre-requisite programs of the software application must be updated to the required revision level.

Although the Examiner asserts that "Donohue clearly disclose that the updating occurs prior to the installation of a subject application component" (emphasis added), a review of the Examiner's cited passages yields exactly the opposite. As already reproduced above, Donohue teaches that "an update is forced on [the pre-requisites'] updater agents." An updater agent is not the same as a pre-requisite (i.e., allegedly corresponding to the claimed "ones of said dependencies"). Instead, the updater agent is the device that performs the update on the pre-requisite. A review of the remainder of column 20 fails to yield any teachings as to when the updating of the pre-requisite occurs.

Referring to column 20, line 65 through column 21, line 9, Donohue discusses the installation of the "actual software update." These passages, however, are also silent as to when the updater agent updates the pre-requisites in comparison to when the subject application component is installed. Thus, although Donohue teaches that the update is forced on the updater

agents, the teachings of Donohue is unclear as to when the updater agents update the pre-requisites, either prior to, while, or after, the subject application component being installed.

The Examiner further argued the following in the paragraph spanning pages 14 and 15 of the Examiner's Answer:

Appellant further argues that the software in Donohue is not referred to as "software to be installed," but instead as installed software (*see Appeal Brief—page 7*). Examiner disagrees. The "software to be installed" in Donohue is referred to as software updates (e.g., fixes, additions, and new versions). Donohue discloses an updater agent, which accesses relevant network locations and automatically downloads and **installs any available updates to its associated program** if those updates satisfy predefined update criteria of the updater agent (*see Abstract*). (emphasis in original)

Although the Examiner disagrees with Appellants' assertion that Donohue refers to "installed software," reference is made to column 5, lines 54-62 of Donohue, which is reproduced below:

An updater component according to a preferred embodiment of the invention performs a comparison between available software updates and installed software on the local computer system to identify which are relevant to the installed software, compares the available relevant updates with update criteria held on the local computer system (these update criteria are predefined for the current system or system user), and then automatically downloads and applies software updates which satisfy the predefined criteria. (emphasis added)

As clearly described therein, the software is already installed, and the updater component of Donohue is described as automatically applying software updates that are relevant the installed software, which supports Appellants' assertions regarding Donohue.

The Examiner's assertion that the "software to be installed" is referred to in Donohue as "software updates" does not support the Examiner's analysis. Instead, this assertion shows the Examiner's analysis to be flawed. As already noted, the claims recites that the updates to the "dependencies" occur prior to installation of the subject application component. However, by asserting that the "software updates" are "software to be installed," the Examiner is admitting

that the software updates are installed after the "installed software" described in the above-reproduced passage in Donohue.

On page 15 of the Examiner's Answer, the Examiner then argued the following:

Furthermore, Appellant alleges that Donohue fails to teach or suggest the limitation of the enforcing step be performed "prior to installing said subject application component" (emphasis in original) (*see Appeal Brief - page 7*). Examiner would like to again point out that Donohue is relied upon solely for the rejection of the particular claim limitation "updating dated ones of said required ones of said dependencies which can be accessed in said target platform with updated versions of said required ones of said dependencies" and not the particular limitation of the enforcing step be performed "prior to installing said subject application component," which Zimniewicz et al. clearly disclose [reproduced passages omitted] Thus, before the installation of the suite can begin, a check is performed to make sure all the dependency requirements and hardware requirements are met. Appellant has not presented arguments against this interpretation.

Both of these assertions have already been addressed. By failing to consider all of the teachings of Donohue, the Examiner has to properly consider the entirety of Donohue. Moreover, notwithstanding whether or not Donohue teaches that "before the installation of the suite can begin, a check is performed to make sure all the dependency requirements and hardware requirements are met," as alleged by the Examiner, the Examiner has fail to establish when the dependency requirements are met (i.e., by "updating dated ones of said required ones of said dependencies") versus when the subject application component is installed.

On pages 7 and 8 of the Appeal Brief, Appellants argued that not only is Donohue silent as to when the updating occurs, but Zimniewicz is also silent as to when updating occurs. The Examiner's response to these arguments is found on page 16 of the Examiner's Answer and reproduced, in part, below:

Appellant further argues that Zimniewicz et al. is also silent with regard to when any updating occurs (emphasis in original) (see *Appeal Brief* - page 7). Examiner disagrees. Zimniewicz et al. clearly disclose that the updating occurs prior to the installation of a subject application component (see *Figure 3; Column 7: 63-67 through Column 8: 1 and 2, "The installation process is actually divided into two primary stages: baseline and install."; Column 8: 18-25, "A baseline is a requirement determined by the suite owner. It concerns what OS/applications must be on a user's machine before installation of the suite can begin."; Column 9: 51-63, "The Setup Manager also installs 102, when necessary, components needed to achieve the scenario baseline if it differs from the suite baseline. This may occur, e.g., when a third party modifies a scenario data file, but neglects to modify the setup data file. As a result, the scenario baseline is no longer a subset of the suite baseline and requires the installation of additional components."; Column 10: 1-10, "... the data file shipped with a suite can be modified and shipped on a third party supplied CD and "In this case, the Setup Manager will load the updated data file containing third-party product information as part of the startup.").* Thus, prior to launching the installation stages, the data file is updated with modified third-party information and then loaded by the Setup Manager. (emphasis in original)

Notwithstanding the Examiner's extensive citations, Appellants note that absence of a teaching as to when "the data file is updated with modified third-party information," as alleged by the Examiner, as compared to when the subject application component is installed.

Moreover, even if Zimniewicz could somehow be construed as teaching that the data file is updated prior to the installation of the subject application component, the Examiner has not explained a realistic rationale that would lead one having ordinary skill in the art to perform the claimed "updating dated ones of said required ones of said dependencies" prior to the installation of he subject application component.

For the reasons set forth in the Appeal Brief of March 29, 2007, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. §§ 101, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 6, 2007

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320